



Docket No.: 1247-0862-6E



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COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

RE: Application Serial No.: 09/534,973

Applicants: Remy BADIN, et al.

3RD RCE February 1, 2005

Filing Date:

For: HOLLOW GLASS PRODUCT WITH OFFSET
COLLAR AXIS AND PROCESS OF
MANUFACTURING THE SAME

Group Art Unit: 3727

Examiner: CRONIN, S.

SIR:

Attached hereto for filing are the following papers:

Appeal Brief w/ Claims Appendix

Our credit card payment form in the amount of \$500.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF

REMY BADIN, ET AL.

: EXAMINER: CRONIN, S.

SERIAL NO: 09/534,973

: GROUP ART UNIT: 3727

3RD RCE FILED: FEBRUARY 1, 2005
FOR: HOLLOW GLASS PRODUCT WITH
OFFSET COLLAR AXIS AND PROCESS
OF MANUFATURING THE SAME

APPEAL BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

This is an appeal from a final Office Action mailed on September 9, 2005, for which a Notice of Appeal was timely filed on December 9, 2005.

REAL PARTY IN INTEREST

The real party in interest in the present appeal is SAINT-GOBAIN EMBALLAGE having a place of business at 18 avenue d'Alsace F-92400 Courbevoie, France.

RELATED APPEALS AND INTERFERENCES

Appellant, appellant's legal representatives, and assignee are not aware of any other appeals, interferences, or judicial proceedings that will directly effect or be directly affected by or have a bearing on the board's decision in the pending appeal.

STATUS OF CLAIMS

Claims 1-5 and 16-33 are pending in this application and are being appealed. Claims 1-5 and 16-33 stand rejected and Claims 6-15 have been canceled.

STATEMENT OF AMENDMENTS

In response to the Final Office Action mailed on September 9, 2005, Appellants filed a Request for Reconsideration on October 24, 2005. No amendments under 37 C.F.R. § 1.116 were submitted after receipt of the outstanding Final Office Action of September 9, 2005. On November 10, 2005, an Advisory Action was mailed indicating that the Request for Reconsideration previously filed was considered, but it failed to place the application in condition for allowance. On December 9, 2005, a Notice of Appeal was filed together with Remarks Accompanying a Pre-Appeal Brief Request for Review. Finally, on January 11, 2006, a Notice of Panel Decision from Pre-Appeal Brief Review was received, indicating that the Appeal process should proceed to the BPAI.

SUMMARY OF CLAIMED SUBJECT MATTER

As shown as a non-limiting illustration of the instant invention in FIG. 1 of Appellants' specification,¹ the invention recited in independent Claim 1 is directed to a glass product comprising: a main container body 4 having a closed bottom; a secondary container body 5; and a collar 13 opened to an exterior of the product interposed between and communicating with the main container body and the secondary container body, the collar

¹ It is Appellants' understanding that, under the new rules of Practice before the Board of Patent Appeals and Interference, 37 C.F.R. § 41.37(c) requires that a concise explanation of the subject matter recited in each independent claim be provided with reference to the specification by page and line numbers and to the drawings by reference characters. However, Appellants' compliance with such requirements anywhere in this document should in no way be interpreted as limiting the scope of the invention recited in all pending claims, but simply as non-limiting examples thereof.

having an axis 8 not parallel to an axis 11 of the main container body and an axis 12 of the secondary container body, the collar being integral with the main and secondary container bodies, and the collar extending beyond a cross section of the main body.

In independent Claim 18, a glass product is recited, comprising: a main container body 4 having a closed bottom; a secondary container body 5; and a collar 13 opened to an exterior of the product interposed between and communicating with the main container body and the secondary container body, wherein the collar is integral with the main and secondary container bodies, the main container body is configured to extend along an axis 11 of the main container body in an about vertical direction, the collar is configured to extend along an axis 8 of the collar at a first angle relative to the axis 11 of the main container body, and the secondary container body is configured to extend along an axis 12 of the secondary container body at a second angle relative to the axis of the collar, when a bottom surface of the main container body contacts a surface on which the glass product is to be disposed.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The grounds for rejection to be reviewed on appeal and outstanding in the present application are as follows: (1) the combination of Paley (U.S. Patent No. 1,971,164) with Jennings (U.S. Patent No. 4,079,859) to support a rejection of Claims 1-5 and 16-33 under 35 U.S.C. § 103(a); and (2) independent from their dependency from either Claim 1 or Claim 18, the combination of Paley and Jennings to support a rejection of Claims 24, 27, and 30-33 under 35 U.S.C. § 103(a).

ARGUMENT

As a summary of the arguments to be presented next, Appellants note first that there is no motivation to combine Paley with Jennings because Paley teaches away from the proposed combination and modification. In addition, the resulting combination of Paley and Jennings does not teach nor disclose the recited features of the invention, including in Claims 24, 27, and 30-33.

Rejection of Claims 1-5 and 16-33 under 35 U.S.C. § 103(a)

Appellants respectfully request that the Board reverse the Examiner's rejection of Claims 1-5 and 16-33 under 35 U.S.C. § 103(a) because Paley and Jennings, neither individually nor in any combination, support a *prima facie* case of obviousness of the invention recited in independent Claims 1 and 18 since Paley teaches away from the proposed combination.

During the examination process of patent application, it is well known that “a *prima facie* case of obviousness may [] be rebutted by showing that the art, in any material respect, teaches away from the claimed invention”² and, furthermore, that it “is improper to combine references where the references teach away from their combination.”³

The outstanding Office Action acknowledges that several features of the claimed invention are not taught or disclosed by Paley. In particular, it is acknowledged that Paley fails to disclose a collar extending beyond a cross section of the main container body. Jennings is cited as allegedly correcting the acknowledged deficiencies of Paley. The Outstanding Office Action asserts that the modification to make the proposed modification of

² MPEP § 2144.05, citing *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997).

³ M.P.E.P. §2145(X)(D)(2), citing *In re Grasselli*, 713 F.2d 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983).

Paley with the teachings of Jennings is that both are directed to “providing a means for dispensing measured liquids.”

Applicants respectfully disagree and submit that, even if assuming *in arguendo* that Jennings relates to techniques and apparatuses for measuring liquids and granular materials, Paley relates to bottles for testing butter, cheese, cream, milk, and the like substances for fat content and not for dispensing them. In addition, Paley teaches away from the proposed modification and would be rendered unsatisfactory for its intended use of the proposed substantial reconstruction were to be implemented.

In effect, the outstanding final rejection does little more than attempt to show that parts of the inventive combination of Claims 1 and 18 were individually known in other arts and to suggest that such a showing is all that is necessary to establish a valid case of prima facie obviousness. The PTO reviewing court recently reviewed such a rationale and dismissed it in as follows:⁴

“As this court has stated, “virtually all [inventions] are combinations of old elements.” Environmental Designs, Ltd. v. Union Oil Co., 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); see also Richdel, Inc. v. Sunspool Corp., 714 F.2d 1573, 1579 80, 219 USPQ 8, 12 (Fed. Cir. 1983) (“Most, if not all, inventions are combinations and mostly of old elements.”). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.” Sensonics, Inc. v. Aerasonic Corp., 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996). To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the

⁴ *In re Rouffet*, 149 F. 3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998).

elements from the cited prior art references for combination in the manner claimed.”

There has been no such showing of those required reasons made in the final rejection.

In Paley, as illustrated in all drawing illustrations of that patent, there is no inclination of the reading tube 19 with respect to the body portion 11. In addition, “the tube 19 and neck 17 are substantially wholly within the horizontal cross-sectional circular outline of the body 11. With this construction the bottle 10 may be readily fitted into the seat or container on the centrifuging machine.”⁵ In the second embodiment disclosed by Paley, “the outer rim 25 of the neck 17a, however, is disposed wholly within the circular outline of the body, as shown in FIG. 4 of the drawing.”⁶ In fact, in the invention claimed, “said reading tube and inlet opening being wholly contained within the transverse circular outline of the body of the bottle.”⁷

In Jennings, a technique and apparatus for measuring liquids and granular materials comprising a measuring head which may either take the form of an attachment to or an integral part of a conventional primary container. The measuring head comprises two elements: (1) an upwardly extended modifying pour spout seated on the mouth of the primary container and disposed at an acute clockwise angle to the axis of the primary container; and (2) a measuring vessel which encloses or is coupled to the modifying pour spout of the primary container, and which has its own dispensing mouth disposed at a counterclockwise angle relative to the axis of the primary container (see, the abstract of Jennings). These

⁵ Paley, page 1, lines 93-98.

⁶ Paley, page 2, lines 25-28.

⁷ Paley, Claim 1.

disparate reference teachings further raise a question of why the artisan would even consider these references for combination, a question the PTO must answer.⁸

The patentability standard for a case of obviousness requires that a reference be considered as a whole. "Portions arguing against or teaching away from the claimed invention must be considered."⁹ Appellants assert that, based on the above-summarized disclosure and claimed subject matter, Paley "would likely *discourage* the art worker from attempting the modification suggested by [the Office]."¹⁰ Additionally, "it is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teaching of the prior art so that the claimed invention is rendered obvious One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."¹¹

If the container of Paley were to be modified as proposed by the Office, contrary to the specific teachings of that reference, the resulting modification would either not readily fit into the seat or container on the centrifuging machine (thus, rendering the modified container unsatisfactory for its intended use) or that machine would have to be substantially modified in order to accommodate a container comprising a reading tube and an inlet or mouth extending from the cross section of the bottle 13 in directions other than the disclosed vertical direction (thus, requiring a substantial reconstruction and redesign). However, "if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified" or "the suggested combination of references would require a substantial reconstruction and redesign of the elements shown,"

⁸ See *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), requiring the PTO to "explain the reasons one of ordinary skill in the art would have been motivated to select the references"

⁹ *Bausch & Lomb, Inc. v. BarnesHind/Hydrocurve, Inc.*, 230 USPQ 416 (Fed. Cir. 1986).

¹⁰ *Gillette Co. v. S.C. Johnson & Son, Inc.*, 16 USPQ2d 1923 (Fed. Cir. 1990).

¹¹ *In re Fritch*, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992).

then there is no motivation to combine or modify the references.¹² Appellants respectfully submit that there is no evidence that a person of ordinary skill in the art would be motivated to perform such changes and redesign.

In response to the arguments filed on October 24, 2005, the Advisory Action of November 10, 2005 asserted that the Request for Reconsideration previously filed had been considered but did not place the application in condition for allowance because:

The combination of the references as applied are still deemed proper for the reasons set forth in the claims. As to the specific size, shape, and glass content argued by applicant, these are considered inherent in the prior art and/or derived from a result effective variable.¹³

Applicants fail to see the relevance of the above-summarized reason in support of the asserted conclusion that the Request for Reconsideration did not place the application in condition for allowance. There are no reasons set forth in the claims. Furthermore, if the features are inherent in a cited reference (which standard seems questionable and/or irrelevant to an obviousness rejection) and/or derived from a result effective variable, no evidence, let alone substantial evidence, has been provided to support these positions.

Appellants respectfully submit to the Board that, with respect to the statement made about the finding of optimum values of result-effective variables, the cited case law is being incorrectly applied. It is well understood that a “particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation.”¹⁴ Therefore, the statement that “it would have been obvious to one of ordinary skill in the art at the time of the invention was made to form the angle of the

¹² M.P.E.P. §2143.01 (citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

¹³ See Advisory Action of November 10, 2005, continuation of paragraph 11.

¹⁴ See, for example, MPEP § 2144.05, citing *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977).

collar to the main container body and the secondary container body at about 120 degrees, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art,”¹⁵ made in the outstanding Office Action is irrelevant, unless substantial evidence is found in the record supporting a conclusion that the claimed variables are “result-effective.” However, the record is devoid of such evidence.

Accordingly, Appellants respectfully submit that Paley and Jennings cannot support a prima facie case of obviousness of Claim 1 and 18. As to Claim 1, there is no motivation to modify the container of Paley such that the collar extends beyond a cross section of the main body. As to Claim 18, there is no motivation to modify the container of Paley such that the main container body extends along its axis in a vertical direction, the collar extends along its axis at a first angle relative to the axis of the main container body, and the secondary container body extends along its axis at a second angle relative to the axis of the collar. Claims 2-5, 16, 17, and 19-33 should be allowed, among other reasons, as depending either directly or indirectly from Claim 1 or Claim 18, which should be allowed as just explained.

In addition, Claims 2-5, 16, 17, and 19-33 are further considered allowable as they recite other features of the invention that are not disclosed, taught, or suggested by the applied references when those features are considered within the context of the subject matter recited in independent Claims 1 or 18.

For the foregoing remarks, Appellants respectfully request that the rejection of Claims 1-5 and 16-33 under 35 U.S.C. § 103(a) be reversed.

Rejection of Claims 24, 27, 30, 31, 32, and 33 under 35 U.S.C. § 103(a)

¹⁵ See, Outstanding Office Action, page 2, item 3.

Separate from their dependency from either Claim 1 or Claim 18, Appellants respectfully request that the Board reverse the Examiner's rejection of Claims 24, 27, and 30-33 under 35 U.S.C. § 103(a) because the combination of Paley and Jennings does not teach or disclose all of the features recited therein.

As previously explained,¹⁶ the outstanding Office Action fails to explain how several of the features claimed in the dependent claims are taught or disclosed in the cited references. As a non-limiting example, the outstanding Office Action is devoid of any explanation on how or where the following features are taught or disclosed in the cited references: (1) as to Claim 24, the main and secondary container bodies, and the collar are disposed in an about Y-shape; (2) as to Claim 27, the axis of the secondary container body is configured to extend at an angle of about 120° from the axis of the collar, such that the glass product has an about Y-shape; (3) as to Claims 30 and 31, the product is a blown-blown glass product or a press-blown glass product; and (4) as to Claims 32 and 33, the glass product has a single opening.

Based on the foregoing, and separate from their dependency from either Claim 1 or Claim 18, Appellants respectfully request that the obviousness rejection of Claims 24, 27, and 30-33 under 35 U.S.C. §103(a) be reversed.

¹⁶ See the Request for Reconsideration of October 24, 2005, pages 5 and 6.

In view of these foregoing comments, each of the pending Claims 1-5 and 16-33 clearly distinguish over the applied art references, and thus the outstanding rejections thereof must be REVERSED.

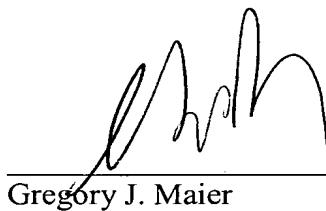
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CLAIMS APPENDIX

1. (Previously Presented) A glass product comprising:
 - a main container body having a closed bottom;
 - a secondary container body; and
 - a collar opened to an exterior of the product interposed between and communicating with said main container body and the secondary container body, said collar having an axis not parallel to an axis of said main container body and an axis of said secondary container body, the collar being integral with the main and secondary container bodies, and the collar extending beyond a cross section of the main body.
2. (Previously Presented) The glass product of Claim 1, wherein said main container body comprises at least 20% of glass in the glass product.
3. (Previously Presented) The glass product of Claim 1, wherein said main container body comprises at least 60% of glass in the glass product.
4. (Previously Presented) The glass product of Claim 1, wherein said axis of said main container body and said axis of said collar form an angle between 60° and 180°.
5. (Previously Presented) The glass product of Claim 4, wherein said axis of said main container body and said axis of said collar form an angle between 90° and 150°.
- 6.-15. (Canceled)

16. (Previously Presented) The glass product of Claim 1, wherein the secondary container body is configured to extend above the collar and the main container body.

17. (Previously Presented) The glass product of Claim 16, wherein the axis of the collar is configured to extend in a direction between horizontal and vertical.

18. (Previously Presented) A glass product, comprising:
a main container body having a closed bottom;
a secondary container body; and
a collar opened to an exterior of the product interposed between and communicating with said main container body and the secondary container body, wherein the collar is integral with the main and secondary container bodies, the main container body is configured to extend along an axis of the main container body in an about vertical direction, the collar is configured to extend along an axis of the collar at a first angle relative to the axis of the main container body, and the secondary container body is configured to extend along an axis of the secondary container body at a second angle relative to the axis of the collar, when a bottom surface of the main container body contacts a surface on which the glass product is to be disposed.

19. (Previously Presented) The glass product of Claim 18, wherein the first and second angles are about equal.

20. (Previously Presented) The glass product of Claim 18, wherein the main and secondary container bodies extend along their axes distances greater than a distance in which the collar extends along its axis.
21. (Previously Presented) The glass product of Claim 18, wherein the main and secondary container bodies have substantially cylindrical shapes.
22. (Previously Presented) The glass product of Claim 21, wherein the collar comprises a substantially cylindrical shape.
23. (Previously Presented) The glass product of Claim 22, wherein the first and second angles are about 120°.
24. (Previously Presented) The glass product of Claim 23, wherein the main and secondary container bodies, and the collar are disposed in about Y-shape.
25. (Previously Presented) The glass product of Claim 1, wherein the axis of the collar is configured to extend at an angle between horizontal and vertical.
26. (Previously Presented) The glass product of Claim 25, wherein the axis of the collar is configured to extend at an angle of about 120° from a bottom surface of the main container body on which the glass product is configured to be disposed.

27. (Previously Presented) The glass product according to claim 26, wherein the axis of the secondary container body is configured to extend at an angle of about 120° from the axis of the collar, such that the glass product has an about Y-shape.

28. (Previously Presented) The glass product according to claim 27, wherein at least one of the main and secondary container bodies, and the collar, has an about cylindrical shape.

29. (Previously Presented) The glass product according to claim 28, wherein each of the main and secondary container bodies, and the collar, have an about cylindrical shape.

30. (Previously Presented) The glass product according to claim 1, wherein the product is a blown-blown glass product or a press-blown glass product.

31. (Previously Presented) The glass product according to claim 18, wherein the product is a blown-blown glass product or a press-blown glass product.

32. (Previously Presented) The glass product according to claim 1, wherein the glass product has a single opening.

33. (Previously Presented) The glass product according to claim 18, wherein the glass product has a single opening.

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Appeal Brief filed herewith

EVIDENCE APPENDIX

NONE

Application No. 09/534,973
Appeal Brief filed herewith

RELATED PROCEEDINGS APPENDIX

NONE